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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/012,272 01/23/98 LEE

8 028870-080

EXAMINER

PAK, J

ART UNIT	PAPER NUMBER
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1616

DATE MAILED:

09/13/01

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BURNS DOANE SWECKER & MATHIS L L P
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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

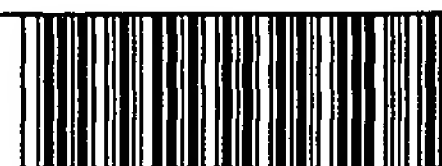
Office Action Summary

Application No.
09/012,272

Applicant(s)
LEE ET AL.

Examiner
John Pak

Art Unit
1616



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 6, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6, 8, and 9 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 8, and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

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Claims 1-4, 6 and 8-9 are pending in this application.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6 and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greenspan et al. in view of Litkowski et al. for the reasons of record.

Applicant argues that this rejection should be withdrawn because the patent by Greenspan et al. is not prior art under the new provisions of 35 USC 103(c), which are applicable to all applications (including CPAs) filed on or after 11/29/99. Applicant makes the following statement (pages 3-4 of applicant's reply filed on 6/6/01):

Moreover, the '008 patent [Greenspan et al.] and the present application are both assigned to U.S. Biomaterials Corp. Thus, the patentability of the present invention is not precluded by the '008 patent.

This statement is not sufficient. Applicant's attorney fails to state that the this application and the '008 patent were, **at the time the invention was made**, owned by, or subject to an obligation of assignment to, the same person or entity. Mere subsequent common ownership **after** the invention was made is not sufficient to exclude prior art that qualifies only under 35 USC 102(e).

For the above reasons, this rejection is maintained.

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 6 and 8-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10-11 of U.S. Patent No. 5,834,008 ('008) in view of Litkowski et al. for the reasons of record.

Applicant's arguments relative hereto have been given due consideration but they were deemed unpersuasive. Applicant argues that the '008 patent does not claim a method of treating inflammatory symptoms related to skin disorders other than wounds. However, the instant specification defines skin disorder to mean "abnormalities, other than wounds, of the skin which have induced a state of inflammation." Such disorders include, "but are not limited to warts, acme[sp], dermatitis, hives, psoriasis, rashes, contact allergic reactions, and reactions to insect stings, and bites." See specification page 3, last paragraph.

It is the Examiner's position that the method of grafting skin in claims 10-11 of the '008 patent overlaps with the instant claimed methods. Skin grafts are indicated for dermatitis, as evidenced by Embase Abstracts 85063296 and 76078548. Therefore, claims 10-11 of the '008

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patent clearly encompass topically applying to the site of inflammatory skin disorder such as dermatitis an effective amount of bioactive glass, which would necessarily have been effective to treat inflammatory symptoms since effective skin grafting is without undue inflammation. See also claim 1 of the '008 patent for compositional makeup of suitable bioactive glass.

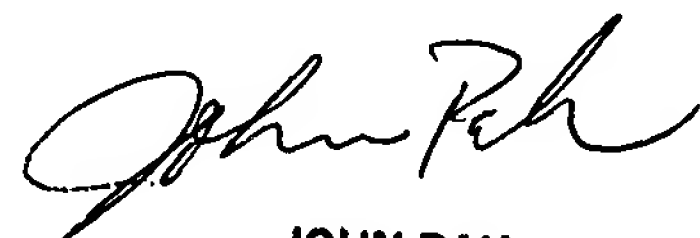
Therefore, one having ordinary skill in the art would have recognized the claims of the instant application as an obvious variant of the invention already patented in claim 10 of the '008 patent.

A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machines are (703) 308-4556 or (703) 305-3592.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Examiner Pak whose telephone number is (703) 308-4538. The Examiner can normally be reached on Monday through Thursday from 8:00 AM to 5:30 PM. The Examiner can also be reached on alternate Fridays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. José Dees, can be reached on (703) 308-4628.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.



JOHN PAK
PRIMARY EXAMINER
GROUP 1200